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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,989	09/26/2001	Roland N. Walker	12160.2	2969
21999	7590	05/16/2006	EXAMINER	
KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			BAHTA, ABRAHAM	
		ART UNIT	PAPER NUMBER	
		1744		
DATE MAILED: 05/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/964,989	WALKER, ROLAND N.	
	Examiner	Art Unit	
	Abraham Bahta	1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 April 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-10, 12-20, 25-27, 31-35 and 37-41 is/are pending in the application.

4a) Of the above claim(s) 1-10, 16-20, 25 and 31-34 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 12-15, 26-27, 35, 37-41 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 26 September 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15, 26-27, 35 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (USP 6,172,328) or Skonecki (USP 5,305,550) in view of Roulleau (USP 5,142,976).

Jones teaches an organic product such as a leaf/ flower petals which may be in a natural configuration (see Fig. 1 and col. 3, lines 43-45) in which the organic product may be marked/etched with a device/laser/galvanometer. The marking may be a message of greeting, expression, identification, information, communication, inscription and advertisement. See col. 1, lines 54-65; col. 3, lines 21-49 and col. 4, lines 21-27. Further, Jones's flower/petal/leaf is natural because Jones is concerned regarding the ability of the leaf to photosynthesize and respire even when the design is provided on the surface of the flower. See col. 3, lines 38-44. Therefore, it is the position of the Examiner that the flower is in an undamaged form.

Skonecki teaches an organic product such as fresh natural flower, such as a rose in a natural configuration in which the product is provided with a personalized message or drawing inscribed on one of its petals. See col. 1, lines 24-38.

Jones or Skonecki do not require pad-printed image; however, Roulleau '976 teaches an organic product in which the surface of the product comprises pad printed image. See col. 1, lines 61-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the organic product of Jones or Skonecki with a pad printed image so as not damage, or etch or cut the surface of the organic product when the image is printed on the surface of the organic product and in order to provide the surface of the organic product with a repeatable and identical image.

Regarding claims 15 and 27, patentability of product-by-process claims is based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Regarding claims 14 and 26, Jones teaches the ornament design or marking formed on the flower/petal may be a message, greeting, expression, identification, information, communication, inscription, advertisement, bar code, inventory marking price information or business message. See Jones col. 3, lines 21-38. In addition, Skonecki teaches the inscription may be personalized message such as the word "congratulations". See Skonecki fig. 1.

Response to Applicant's Argument's/Remarks

Applicant's arguments filed 04/25/06 have been fully considered but they are not persuasive.

The Applicant contends that the new amendment emphasizes limitations not taught or made obvious by the references cited or their combination and that the petal of Applicant's claimed invention remains etch-free and free from cuts at the site on the petal where the images exists; however, the Applicant agrees that Jones' flower is undamaged after the image is provided and argues that on the petal, and at the exact location where the image is placed, the markings left on the petal are unobviously different in Jones than in Applicants' claimed invention. The applicant argues that Jones and Roulleau are not properly combinable because Roulleau's intended function is destroyed and that Roulleau's intended function is to provide decorative motifs on uncooked poultry eggs. Further, the applicant argues that the claim set as amended herein is not made obvious by the cited references because Skonecki teaches a hand-held applicator to create an image that is not repeatable.

The Examiner agrees that Jones and Skonecki do not require pad printing an image onto the flower; however, both references are drawn to a process of providing an image onto the flower. The Examiner also agrees that Roulleau does not require pad printing an image specifically onto a flower. It is noted that applicant's claimed invention is drawn to a product by process namely pad-printing an image onto a flower. However, since Roulleau teaches pad-printing an image onto a delicate organic product such as egg, one of ordinary skill motivated by the desire to place an image onto a flower would find it obvious to use pad-printing process as disclosed by Roulleau to provide an image onto the flower as both the egg and flower are delicate organic products.

The Applicants' further argues that the hand held applicator of Skonecki precludes the ability to mass-produce, i.e., repeatable, identical, pad-printed, image provided on each of the flowers in the group of flowers.

The Applicant further contends that Roulleau teaches of poultry eggs, while Jones teaches specifically of etching, cutting or burning into the surface of the product as such Roulleau's intended function of providing decorative motifs on uncooked poultry eggs using the cutting, burning and etching method and apparatus disclosed in Jones would be unsuccessful and unworkable for Roulleau's intended purpose. The Examiner contends that Jones at col. 3, lines 39-43 teaches because of the unique structure of a leaf, certain problems had to be overcome to be able to adequately produce a marked product without destroying the leaf. Thus, one of ordinary skill in the art motivated by the desire to place an image on a flower/petal/leaf would find it obvious to use a pad in order to print an image on the surface of the flower/petal/leaf disclosed in Jones or Skonecki as shown by Roulleau without cutting/damaging/etching because Roulleau teaches providing a print by a pad printing method without braking or piercing the egg under the force of applying the inking pads. See Roulleau col. 2, lines 12-29. It is to be noted that an egg is a delicate organic product therefore, Roulleau's inking pad would work in the same way, i.e., provide a pad printed image on a delicate organic product such as a flower/petal/leaf free from an etched/cut/burned image.

Any inquiry concerning this communication should be directed to Abraham Bahta whose telephone number is (571) 272-1532. The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the examiner supervisor Gladys Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Bahta

05/09/06



JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
5/12/06